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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,820	02/11/2004	Phillip M. Starr	HES 2003-IP-010244U1	3376
29920	7590	11/13/2006	EXAMINER	
JOHN W. WUSTENBERG P.O. BOX 1431 DUNCAN, OK 73536			BOMAR, THOMAS S	
			ART UNIT	PAPER NUMBER
			3672	
DATE MAILED: 11/13/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/776,820

Applicant(s)

STARR ET AL.

Examiner

Shane Bomar

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-18, 21-24 and 26-38 is/are rejected.
- 7) ☒ Claim(s) 5, 6, 19, 20 and 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 21, 2006 has been entered.

Response to Amendment

2. The declaration under 37 CFR 1.132 filed August 21, 2006 is sufficient to overcome the rejection of claims 1-9, 13, 16, 24-26, 28-30, 32-35, 37, and 38 based upon 35 USC 102(e) since the invention was not "by another".

Claim Objections

3. Claim 2 is objected to because of the following informalities: the recitation of "element at disposal" should be --element for disposal-- to comply with claim 1. Appropriate correction is required.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

5. Claims 1-4, 7-18, 21, 23, 24, 26, 27, and 29-38 are rejected under 35 U.S.C. 102(b) as being anticipated by US 3,062,295 to Hanes.

Regarding claims 1, 29, and 32, Loomis discloses a disposable downhole tool and the associated method for disposing of the tool comprising: an elongated body 6; a slip 10 situated about the body, wherein the slip comprises a plurality of segments 14; a compression element 9 situated about the elongated body; and at least one preconfigured division 19 in the compression element, wherein the tool is capable of being disposed of in a wellbore because any downhole tool is disposable downhole, i.e., since both elements 9 and 10 break apart when being set and the wireline 45 is removed, the plug is left downhole and is thus considered disposable (see Figs. 1-4; col. 2, line 15 through col. 3, line 17; and col. 3, line 56 through col. 4, line 7).

Regarding claim 2-4, 13, 16, 17, and 37, the compression element for disposal of the disposable downhole tool comprises a plurality of preconfigured divisions 19 segmenting the compression element into a plurality of segments 21 that are substantially uniform in size and shape (see Fig. 3).

Regarding claims 7-10, 12, 33, 35, and 36, the preconfigured divisions are at least partly formed downhole in response to at least one segmenting event, the event including compression of the compression element, setting of the disposable downhole tool in a wellbore, and releasing of the wireline 45 leaving the tool in the borehole (see Fig. 4).

Regarding claim 11, when the compression element 9 is first compressed between elements 7, 8, and 10, the metal that is left in divisions 19 at first resists that compression, and thus must be first released from that compressed state to break the divisions (see Figs. 3 and 4).

Regarding claims 14 and 15, the segments are configured to sink in a wellbore while being run-in, and are configured to rise in a wellbore while being raised to the surface.

Regarding claim 18, 21, and 34, the preconfigured divisions at least substantially segment the compression element into the plurality of segments prior to deployment of the disposable downhole tool in a wellbore, and further comprising a retainer to retain the segments in place about the elongated body while positioning the disposable downhole tool in a wellbore, i.e., the metal 18 left in the divisions 19 (see col. 2, lines 62-69).

Regarding claim 23, the preconfigured divisions at least substantially segment the compression element into a plurality of segments prior to deployment of the disposable downhole tool in a wellbore; and the plurality of segments are held together by an interlocking geometry prior to deployment of the disposable downhole tool in the wellbore (see Fig. 3).

Regarding claim 24, another compression element 9 may be used in the upper part of the plug (see col. 4, lines 23-25).

Regarding claims 26, 27, 31, and 38, the compression element is at least part of a sealing element of the disposable downhole tool, and the tool is a disposable well plug (see col. 1, lines 9-20).

Regarding claim 30, the compression element comprises a sealing ring 8 disposed about the body (see Fig. 1).

Regarding claim 33, the method of claim 32 further comprising the step of segmenting the compression element of the downhole tool in response to at least a downhole event (see Fig. 3).

Regarding claim 34, the method of claim 32 wherein the compression element of the downhole tool is at least substantially presegmented prior to deployment of the downhole tool in the wellbore (see Figs. 1 and 2).

Regarding claim 35, the method of claim 32 further comprising the step of segmenting the compression element of the downhole tool in connection with setting the downhole tool in the wellbore (see Fig. 3).

Regarding claim 37, the method of claim 32 further comprising the step of segmenting the compression element of the downhole tool into a plurality of segments (see Fig. 3 and 4).

Regarding claim 38, the method of claim 32 wherein the compression element comprises at least part of a sealing element of the downhole tool (see col. 4, lines 28-31).

6. Claim 28 is rejected under 35 U.S.C. 102(b) as being anticipated by US 5,701,959 to Hushbeck et al.

Hushbeck et al disclose a disposable downhole tool (i.e., the tool is drillable, and therefore disposable as seen in the Abstract) comprising: an elongate cylindrical body 130; and an external sealing element 150/152 situated about the elongated cylindrical body, wherein the external sealing element comprises a plurality of sealing rings (one above and one below packer assembly 128) each presegmented into a plurality of segments 156 (see Figs. 5 and 6, and col. 9, lines 5-9).

Claim Rejections - 35 USC § 103

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

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claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hanes in view of Hushbeck et al.

Hanes teaches the tool of claim 2 that comprises a compression element having preconfigured divisions that segment the compression element. It is further taught that the segments can be bound together by a metal wire or strap. However, it is not expressly taught that the segments are held together by adhesive.

Hushbeck et al teach a tool with a segmented element similar to that of Hanes. It is further taught that the segments are held together, at least in part, with an adhesive prior to deployment of the disposable downhole tool in the wellbore (see col. 10, lines 27-42). It would have been obvious to one of ordinary skill in the art, having the teachings of Hanes and Hushbeck et al before him at the time the invention was made, to modify the segmented compression element taught by Hanes to include the adhesive bonding of Hushbeck et al. One would have been motivated to make such a combination because the references address the narrow problem of segmenting packer or plug elements prior to their deployment downhole, therefore a person seeking to solve that exact problem would consult the references and apply their teachings together.

Response to Arguments

9. Applicant's arguments with respect to claims 1, 28, 29, and 32 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

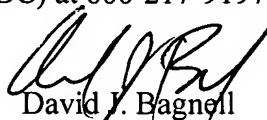
10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Vick et al teach an anchoring device of specific interest. Kisling teaches a segmented slip of particular interest.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shane Bomar whose telephone number is 571-272-7026. The examiner can normally be reached on Monday - Thursday from 6:30am to 4:00pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David J. Bagnell
Supervisory Patent Examiner
Art Unit 3672

tsb



November 2, 2006